REMARKS

Claim Rejections - 35 USC §102

The examiner rejected claims 1, 4-5, 8, 11-12, 15 and 17 under 35 USC §102(e) as anticipated by Elliott et al. (US 6,751,402). The applicant respectfully disagrees for at least the following reasons.

The rejections should be withdrawn because Elliott does not qualify as prior art under 35 USC §102(e). The applicant submits herewith a petition to add Timothy J. Elliott as an inventor to the above-identified patent application. The applicant also submits herewith a declaration under 37 C.F.R. §1.132 stating that prior to the filing date (June 28, 2000) of U.S. Patent No. 6,751,402 the inventors of the above-identified patent application were in joint possession of and had jointly invented the subject matter disclosed in U.S. Patent No. 6,751,402 that relates to the subject matter claimed in the above-identified patent application. Therefore, the related subject matter disclosed in U.S. Patent No. 6,751,402 is not "by another" as required under 35 USC §102(e).

The rejections should also be withdrawn because Elliott does not disclose every element recited in the claims as required under 35 USC §102(e).

Regarding claims 1 and 15, Elliott does not disclose or suggest a digital video recorder (DVR) for maintaining a plurality of program identifiers, and communicating to a set top box (STB) the plurality of program identifiers independent of when the STB demodulates program data identified by the program identifiers, wherein the STB is responsive to the plurality of program identifiers to modify at least one selected operation of the STB.

Regarding claims 8 and 17, Elliott does not disclose or suggest a STB for generating a STB graphical user interface (GUI), receiving a plurality of program

identifiers from a DVR, and modifying at least one selected operation of the STB in response to the plurality of program identifiers.

Claim Rejections - 35 USC §103

The examiner rejected claims 2-3, 6-7, 9-10, 13-14 and 16 under 35 USC §103(a) as being unpatentable over Elliott in view of Official Notice. The applicant respectfully disagrees.

The rejections should be withdrawn because Elliott does not qualify as prior art under 35 USC §103(c). The above-identified patent application was filed on or after November 29th, 1999. The subject matter disclosed by Elliott and the claimed invention were, at the time the invention was made, owned by Western Digital Corporation or subject to an obligation of assignment to Western Digital Corporation. The listed assignees on the face of Elliott are Keen Personal Media, Inc. and Keen Personal Technologies, Inc. (which two corporations are each wholly owned subsidiaries of Western Digital Corporation, Inc.), and assignments recorded in the present case list Keen Personal Media, Inc. as the assignee. Therefore, Elliott and the claimed invention were commonly owned, at the time the present invention was made, by Western Digital Corporation, Inc. See MPEP 706.02(l)(2) ("**Example 1**: Parent Company owns 100% of Subsidiaries A and B – inventions of A and B are commonly owned by the Parent Company").

The rejection should also be withdrawn because Elliott does not disclose or suggest the elements recited in the claims, nor are the elements recited in the claims "notoriously well known" as asserted by the examiner.

Regarding claims 7 and 16, Elliott does not disclose or suggest a DVR for receiving from a STB information identifying a program selected by a user from a STB graphical user interface (GUI), and modifying a plurality of program identifiers in response to the information identifying the program selected by the user from the STB GUI. The examiner failed to identify anything in Elliott that would disclose or suggest these limitations. These limitations are also not "notoriously well known" as suggested by the examiner. "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (In re Fritch 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).)

Regarding claims 14 and 18, Elliott does not disclose or suggest a STB for generating a STB graphical user interface (GUI), and communicating to a DVR information identifying a program selected by a user from the STB GUI. The examiner failed to identify anything in Elliott that would disclose or suggest these limitations. These limitations are also not "notoriously well known" as suggested by the examiner. "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (In re Fritch 972 F.2d 1260; 23 U.S.P.Q.2D (BNA) 1780 (1992).)

The rejections of the remaining claims should be withdrawn for at least the reasons set forth above.

CONCLUSION

In view of the foregoing remarks, the rejections under 35 USC §102 and 35 USC §103 should be withdrawn. The examiner is encouraged to contact the undersigned over the telephone in order to resolve any remaining issues that may prevent the immediate allowance of the present application.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

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